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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/076,409    05/12/98    WALKER    J    WD2-97-563

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EXAMINER

SMITH, D

ART UNIT

PAPER NUMBER

2764

DATE MAILED:

04/13/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/076,409**

Applicant(s)  
**Walker et al**

Examiner  
**Demetra R. Smith**

Group Art Unit  
**2764**



☒ Responsive to communication(s) filed on May 12, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-59 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-59 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### **Part III DETAILED ACTION**

#### ***Information Disclosure Statement***

1. The prior art submitted on 05/12/98 has been considered as indicated on the enclosed copies of form PTO-1449

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-59 are rejected under 35 USC § 101 the claimed invention is directed to non-statutory subject matter.

A review of the disclosure does not show a practical application within the technological arts. The claims are directed to a determining an upsell and generating a coupon.

An evaluation of these steps does not show that the process performs independent physical acts. The process step of "generating a purchase price", "generating a rounded price", "calculating a round-up amount", "determining an upsell", or "outputting a signal", are not sufficient to meet the requirements of physical acts, because they are grounded in the abstract idea of physically performing mathematical manipulations of data. In this regard, the claims merely manipulate data using an abstract mathematical algorithm without any limitation to a practical application within the technological arts.

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4. Claims 13-47 are rejected under 35 USC § 101 the claimed invention is directed to non-statutory subject matter.

A review of the disclosure does not show a practical application within the technological arts. The claims are directed to a method for generating a coupon.

An evaluation of the process does not show that the process performs independent physical acts. The process steps of “generating a purchase price”, “generating a rounded price”, “calculating a round-up amount”, “setting value based”, “printing on the coupon an identifier, and indication”, “receiving an indication”, or “exchanging the round-up”, are not sufficient to meet the requirements of physical acts, because they are grounded in the abstract idea of performing physical manipulating of data. Moreover, none of these claims affirmatively recite physical transformations occurring within a computer. In this regard, the claims are directed to an abstract idea without any limitations to a practical application within the technological arts.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

De Lapa et al (5,822,735) discloses a merchandising system for generating and redeeming product discount coupons prints coupons for a selected consumer from a group of consumers by selecting particular coupons from a group of coupons to provide to the selected consumer and printing the coupons. By obtaining useful marketing data as well as a data base of consumers

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having particular consumption habits, manufacturers may target "free" coupons and the like to consumers most likely to be long-term purchasers of products. The consumer survey could request information regarding the favorite charity of the consumer.

Deaton et al (5,649,114) discloses a system and method for customer promotion that generates a signal representative of a customer's shopping history, wherein incentive coupons may be issued to customers in dependence upon the signal.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Demetra R. Smith**, whose telephone number is (703) 308-6989. The examiner can normally be reached on Tuesday-Friday from 8:00 a.m. to 5:00 p.m. EST.


If attempts to reach the examiner by phone fail, the examiner's supervisor, **James P. Trammell**, can be reached at (703) 305-9768. Additionally, the fax phone for Art Unit 2764 is (703) 308-9051 or 308-9052, (for formal communications intended for entry), or (703) 308-5397 (for informal or draft communications, please label "PROPOSED" OR "DRAFT").

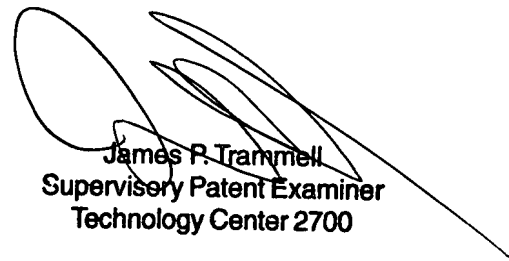
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Demetra.Smith@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-3900.

  
**Demetra R. Smith**  
Patent Examiner  
Group Art Unit 2764  
April 12, 1999

  
**James P. Trammell**  
Supervisory Patent Examiner  
Technology Center 2700